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| Date: March 05, 2001 | Client & Matter Number : 018547-040820US | No. Pages (including this one): 9 |
| To: Examiner Jeffrey Siew USPTO | At Fax Number: 703-872-9306 | Confirmation Phone Number: 571-272-0807 |

From : Joe Liebeschuetz

(5218)

Message: USSN 09/779,389 Attorney Docket #018547-040820US

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Mr Celsa:

Please find attached a copy of the Request for Signed Copy of Previously Submitted Information Disclosure Statement for the above-referenced application.

Thank you,

Joe Liebeschuetz

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60230207 v1

**PATENT APPLICATION
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60230259 v1

EXPRESS MAIL NO.:

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|---------------|--|------------------|------------------|
| Mailing Date: | June 2, 2004 | Application No.: | 09/779,389 |
| File No.: | 018547-040820US | Attorney: | JOL/drm |
| Inventor(s): | KOMASE et al. | Filed: | February 7, 2001 |
| Title: | METHODS FOR IMPROVED ARRAY PREPARATION | | |

The following items are enclosed:

1. Request for Signed Copy of Previously Submitted Information Disclosure Statement w/Attachment of previously submitted IDS Statement and Postcard, and
2. Return Postcard.

Please stamp the date of receipt of the enclosed documents and return this card to addressee.

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Patent Examining Group 1639 at Fax No. 1-703-872-9306 on June 2, 2004.

PATENT
Docket No.: 018547-040820US
Client Ref. No.: 3253.2

TOWNSEND and TOWNSEND and CREW LLP

By: 

D'Evelyn R. Moran

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McGall et al.

Application No.: 09/779,389

Filed: February 7, 2001

For: METHODS FOR IMPROVED
ARRAY PREPARATION

Examiner: Bennett Celsa

Art Unit: 1639

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STATEMENT

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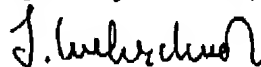
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submitted an Information Disclosure Statement on May 7, 2001, together with copies of cited references. A copy of the statement and a postcard showing receipt therewith by the U.S. PTO are attached. Applicants have not previously received a signed copy of the information disclosure statement and request this now be sent, preferably via facsimile to 650-326-2422.

Respectfully submitted,



Joe Liebeschuetz
Reg. No. 37,505

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Two Embarcadero Center, Eighth Floor
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Tel: (415) 576-0200
Fax: (415) 576-0300
JOL/drm

TO THE U.S. PATENT AND TRADEMARK OFFICE

Please stamp the date of receipt of the following document(s) and return this card to us

RE: McGall et al

TITLE OF DOCUMENT(S):

Information Disclosure Statement

PTO-1449

7 References



Application No.: 09/779,389

File No. 18547-040820

Date Due _____

Date Mailed: 5/7/01

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SF 1018344 v1

MAY 18 2001

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PATENT
Attorney Docket No.: 18547-040820US
Client Reference No.: 3253.1

Assistant Commissioner for Patents
Washington, D.C. 20231

On May 7, 2001

TOWNSEND and TOWNSEND and CREW LLP

By: Jennifer K. Hardi

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McGall et al.

Application No.: 09/779,389

Filed: February 7, 2001

For: U.S. CONTINUATION PATENT
APPLICATION FOR: METHODS FOR
IMPROVED ARRAY PREPARATION

Examiner: Barba M. Koroma

Art Unit: 1627

INFORMATION DISCLOSURE
STATEMENT UNDER 37 CFR §1.97 and
§1.98

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The references cited on attached form PTO-1449 are being called to the attention of the Examiner. Copies of the references are enclosed. It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and

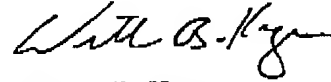
PATENT

McGall et al.
Application No.: 09/779,389
Page 2

no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement, since it is being submitted prior to the first Office Action. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



William B. Kezer
Reg. No. 37,369

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Tel: 925 472-5000
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SF 1221350 v1

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PTO/SB/08A (08-09)Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet 1 of 3

Complete if Known

| | |
|------------------------|----------------------|
| Application Number | 09/779,389 |
| Filing Date | February 7, 2001 |
| First Named Inventor | McGall, et al. |
| Group Art Unit | 1632 |
| Examiner Name | Barba M. Koroma, PhD |
| Attorney Docket Number | 18547-040820US |

U.S. PATENT DOCUMENTS

| Examiner Initials * | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document MM-DD-YYYY | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|---------------------|-----------------------|----------------------|-----------------------------------|---|--|---|
| | | Number | Kind Code ² (if known) | | | |
| | 1 | 5,143,854 | | Pirrung et al. | 9/1/92 | |
| | 2 | 5,242,979 | | Barnum et al. | 9/7/93 | |
| | 3 | 5,252,743 | | Barrett et al. | 10/12/93 | |
| | 4 | 5,288,514 | | Ellman | 2/22/94 | |
| | 5 | 5,324,533 | | Fodor et al. | 6/28/94 | |
| | 6 | 5,324,663 | | Lowe | 6/28/94 | |
| | 7 | 5,384,281 | | Winkler et al. | 1/24/95 | |
| | 8 | 5,405,783 | | Pirrung et al. | 4/11/95 | |
| | 9 | 5,412,087 | | McGall et al. | 5/2/95 | |
| | 10 | 5,424,188 | | Fodor et al. | 6/13/95 | |
| | 11 | 5,445,834 | | Fodor et al. | 8/29/95 | |
| | 12 | 5,451,883 | | Barrett et al. | 9/19/95 | |
| | 13 | 5,482,887 | | Barrett et al. | 1/8/96 | |
| | 14 | 5,489,878 | | Fodor et al. | 2/6/96 | |
| | 15 | 5,491,074 | | Aldwin et al. | 2/13/96 | |
| | 16 | 5,510,270 | | Fodor et al. | 4/23/96 | |
| | 17 | 5,527,681 | | Holmes | 6/18/96 | |
| | 18 | 5,545,531 | | Rava et al. | 8/13/96 | |
| | 19 | 5,547,839 | | Dower et al. | 8/20/96 | |
| | 20 | 5,580,215 | | Holmes | 8/27/96 | |
| | 21 | 5,588,752 | | Lockhart et al. | 9/17/96 | |
| | 22 | 5,571,638 | | Hubbell et al. | 11/5/96 | |
| | 23 | 5,578,832 | | Yulison et al. | 11/26/96 | |
| | 24 | 5,593,839 | | Hubbell et al. | 1/14/97 | |
| | 25 | 5,608,895 | | Pease et al. | 2/4/97 | |
| | 26 | 5,824,711 | | Sundberg et al. | 4/29/97 | |
| | 27 | 5,831,734 | | Stam et al. | 5/20/97 | |
| | 28 | 5,858,734 | | Brock, et al. | 8/19/97 | |
| | 29 | 5,677,195 | | Winkler et al. | 10/14/97 | |
| | 30 | 5,710,000 | | Sapolsky et al. | 1/20/98 | |
| | 31 | 5,744,101 | | Fodor et al. | 4/28/98 | |
| | 32 | 5,744,305 | | Fodor et al. | 4/28/98 | |
| | 33 | 5,753,788 | | Fodor et al. | 5/19/98 | |
| | 34 | 5,770,456 | | Holmes | 6/23/98 | |
| | 35 | 5,800,992 | | Fodor et al. | 9/1/98 | |
| | 36 | 5,831,070 | | Pease et al. | 11/3/98 | |
| | 37 | 5,843,656 | | McGall | 12/1/98 | |
| | 38 | 5,859,011 | | Sogabe | 1/5/99 | |
| | 39 | 6,019,523 | | Sundberg et al. | 7/8/99 | |
| | 40 | 6,022,983 | | McGall et al. | 2/8/00 | |
| | 41 | 6,045,996 | | Cronin et al. | 4/4/00 | |

Examiner Signature

Date Considered

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¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

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**INFORMATION DISCLOSURE
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Sheet 2 of 3

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| | |
|------------------------|-----------------------|
| Application Number | 09/779,389 |
| Filing Date | February 7, 2001 |
| First Named Inventor | McGall, et al. |
| Group Art Unit | 1632 |
| Examiner Name | Barba M. Koroma, PhD. |
| Attorney Docket Number | 18547-040820US |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document MM-DD-YYYY | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ² |
|--------------------|-----------------------|-------------------------|---------------------|-----------------------------------|---|--|---|--------------------------|
| | | Office | Number ³ | Kind Code ⁴ (if known) | | | | |
| | 42 | PCT | WO 92/10183 | | Hill | 6/25/92 | | <input type="checkbox"/> |
| | 43 | PCT | WO 99/00730 | | Trémbay et al | 1/7/99 | | <input type="checkbox"/> |
| | 44 | PCT | WO 93/04145 | | Inoue et al. | 3/4/93 | | <input type="checkbox"/> |
| | 45 | PCT | WO 97/10365 | | Lockhart et al. | 3/20/97 | | <input type="checkbox"/> |
| | 46 | PCT | WO 92/10092 | | Fodor et al. | 6/25/92 | | <input type="checkbox"/> |
| | 47 | PCT | WO 94/10128 | | Holmes et al. | 5/11/94 | | <input type="checkbox"/> |
| | 48 | PCT | WO 00/61282 | | Glazer et al. | 10/19/00 | | <input type="checkbox"/> |
| | 49 | PCT | WO 00/21987 | | McGall et al. | 04/20/00 | | |
| | 50 | PCT | WO 00/06771 | | McGall et al. | 02/10/00 | | |
| | 51 | PCT | WO 99/54509 | | McGall et al. | 10/28/99 | | |
| | 52 | PCT | WO 99/40105 | | Goldberg et al. | 02/12/99 | | |
| | 53 | PCT | WO 98/39348 | | McGall et al. | 09/11/98 | | |
| | 54 | PCT | WO 98/20967 | | Beecher et al. | 05/22/98 | | |
| | 55 | PCT | WO 97/39151 | | Goldberg et al. | 10/23/97 | | |
| | 56 | PCT | WO 97/43450 | | Cronin et al. | 11/20/97 | | |
| | 57 | PCT | WO 97/27317 | | Lockhart et al. | 07/31/97 | | |
| | 58 | PCT | EP 742287 | | McGall et al. | 11/13/96 | | |
| | 59 | PCT | EP 7288520 | | Pease et al. | 08/28/96 | | |
| | 60 | EPO | EP 549107 | | Western et al. | 12/29/97 | | |
| | 61 | EPO | 967217 A2 | | McGall et al. | 12/29/99 | | |

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
|--------------------|-----------------------|---|--------------------------|
| | 62 | MCGALL et al., "The Efficiency of Light-Directed Synthesis of DNA Arrays on Glass Substrates" <i>Journal of the American Chemical Society</i> , 1997, Pages 5081-5090, Vol. 119, No. 22 | <input type="checkbox"/> |
| | 63 | LOCKHART et al., "Expression monitoring by hybridization to high-density oligonucleotide arrays" <i>Nature Biotechnology</i> , 1996, Pages 1675-1680, Vol. 14 | <input type="checkbox"/> |
| | 64 | SAIZIEU et al., "Bacterial transcript imaging by hybridization of total RNA to oligonucleotide arrays" <i>Nature Biotechnology</i> , 1998, Pages 45-48, Vol. 16 | <input type="checkbox"/> |
| | 65 | CHEE et al., "Accessing Genetic Information with High-Density DNA Arrays" <i>Science</i> , 1996, Pages 610-614, Vol. 274 | |

Examiner
SignatureDate
Considered

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| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) | | Application Number | 09/779,389 |
| | | Filing Date | February 7, 2001 |
| | | First Named Inventor | McGall, et al. |
| | | Group Art Unit | 1632 |
| | | Examiner Name | Barba M. Koroma, PhD |
| Sheet 3 of 3 | Attorney Docket Number | 18547-040820US | |

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|----|---|--|
| 66 | McGALL <i>et al.</i> , "High-density oligonucleotide probe arrays" <i>Proc. SPIE-Int. Soc. Opt. Eng.</i> , 2000, Pages 106-110, Vol. 3926 (Advances in Nucleic Acid and Protein Analyses, Manipulation, and Sequencing) | |
| 67 | WALLRAFF <i>et al.</i> , "Lithographic techniques for the fabrication of oligonucleotide arrays" <i>J. Photopolym. Sci. Technol.</i> , 2000, Pages 551-558, Vol. 13 | |
| 68 | GLAZER <i>et al.</i> , "High Surface Area Substrates for DNA Arrays" <i>Mat. Res. Soc. Symp. Proc.</i> , 1999, Pages 371-6, Vol. 576 | |
| 69 | FIDANZA <i>et al.</i> , "High-Density Nucleoside Analog Probe Arrays for Enhanced Hybridization" <i>Nucleosides and Nucleotides</i> , 1999, Pages 1293-1295, Vol. 18 | |
| 70 | HACIA <i>et al.</i> , "Enhanced High Density Oligonucleotide Array Based Sequence Analysis using Modified Nucleotide Triphosphates" <i>Nucleic Acids Res.</i> , 1998, Pages 4975-4982, Vol. 26 | |
| 71 | PIRRUNG <i>et al.</i> , "Proofing of Photolithographic DNA synthesis with 3', 5' - dimethoxybenzoinyloxycarbonyl-protected deoxy-nucleoside phosphoramidites" <i>J. Org. Chem.</i> , 1998, Pages 241-246, Vol. 63 | |

| | | | |
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| Examiner Signature | | Date Considered | |
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| Substitute for form 1449A/PTO | | Complete If Known | |
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) | | Application Number | 09/779,389 |
| | | Filing Date | February 7, 2001 |
| | | First Named Inventor | McGall, et al. |
| | | Group Art Unit | 1632 |
| | | Examiner Name | Barba M. Koroma, PhD |
| Sheet 4 of 4 | Attorney Docket Number | 18547-040820US | |

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